

PRE-APPEAL BRIEF REQUEST FOR REVIEW

(filed with the Notice of Appeal)

Docket Number 042933/302069

Application Number: 10/089,992

Filed: July 10, 2002

First Named Inventor: Jonathan Sharp

Art Unit: 2617

Examiner: Dai A. Phuong

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheets.

Respectfully submitted,



Michele M. Glessner
Registration No. 58,713

Date September 19, 2008

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON SEPTEMBER 19, 2008.

Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

Applicants are requesting a Pre-Appeal Brief Request for Review on the basis that the Examiner has failed to show that the cited art, alone or in combination, teaches or suggests each and every element as set forth in the claims in an obviousness rejection under 35 U.S.C. §103(a).

I. Introduction

Claims 1–12 and 14–21 stand rejected under a Final Office Action dated June 19, 2008. Specifically, Claims 1–7, 9–12, and 14–21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,731,959 to Kumagai et al. (hereinafter “Kumagai”) in view of U.S. Patent No. 6,332,024 to Inoue et al. (hereinafter “Inoue”). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumagai in view of Inoue and further in view of U.S. Patent No. 6,519,475 to Kim (hereinafter “Kim”). Claim 13 was canceled in the previous amendment. Claims 2–12, 14, and 16–21 are also rejected based on 35 U.S.C. § 112 as having insufficient antecedent basis.

Independent Claims 1 and 15 are directed to a device including a body, a cover, and “keys accessible when the cover is in a closed position, one of said keys being multifunctional.” Independent Claim 1 recites, in part, that the multifunctional key is “in a position remote from all other keys.” Independent Claim 15 recites, in part, that the multifunctional key is “the only key disposed on a first surface of the cover.” In both independent claims, “the function of the multifunctional key is dependent upon the state of the device.” Furthermore, the multifunctional key is “arranged to be active when the cover is in the closed position and inactive when the cover is in the open position.” Claims 2–12 and 14 depend from Claim 1, and Claims 16–21 depend from Claim 15.

None of the references, alone or in combination, teaches or suggests “keys accessible when the cover is in the closed position, one of said keys being multifunctional and in a position remote from all other keys” (Claim 1) or “one of said keys being multifunctional and being the only key disposed on a first surface of the cover” (Claim 15). Therefore, Claims 1 and 15, and the claims that depend therefrom, are patentable.

II. Rejection under 35 U.S.C. § 112

Claims 2–12, 14, and 16–21 are rejected based on 35 U.S.C. § 112 as having insufficient antecedent basis. Applicant disagrees with the Examiner’s rejection and notes that using “A device” is appropriate in dependent claims. In particular, MPEP § 608.01(n)(A) lists 11 examples of “acceptable” claim wording in

which “A gadget” is claimed. Thus, the wording used in Claims 2–12, 14, and 16–21 is proper, and the rejection is traversed.¹

III. Description of Prior Art

The Kumagai patent discloses a portable telephone that can be used without opening the lid. In one embodiment, the phone includes a body **15** covered by a lid **17** and a liquid crystal section **12**. *See* Kumagai, Fig. 5; col. 3 line 61 through col. 4 line 30. The telephone has multiple keys **30**, **31**, **32a**, **32b** that are accessible on the lid **17** when the lid is closed. *Id.* Actuation of a hook switch **31** on the surface of the lid answers an incoming call when the lid is closed so that the user can talk over the phone without opening the lid. Col. 4, lines 18–22. Telephone directory retrieving keys **32a**, **32b** may be used to scroll a telephone directory and retrieve a party’s telephone number. Col. 4, lines 25–28. In this condition, a transmitting button **30** may be depressed to transmit a call to the selected party. Col. 4, lines 28–30.

The Inoue patent discloses a mobile telephone **1** with an LCD display screen **2** on the case of the telephone **1** and a main soft key **3** located below the display screen **2**. *See* Inoue, Fig. 1; col. 5, lines 1–8. Auxiliary soft keys **4A**, **4B** are also included, “located on the two sides of the main soft key **3** respectively as operation keys.” Col. 5, lines 8–11. A flip **9** is attached to the lower section of the case such that it covers a ten-key and power/confirm key group **5** when the flip **9** is in the closed position. Col. 5, lines 43–45. In this way, the main soft key **3** and auxiliary soft keys **4A**, **4B** are visible all the time, regardless of the position of the flip **9**. Col. 5, lines 45–56.

IV. Analysis of Prior Art

A. Kumagai does not teach or suggest a key wherein the function of the key is dependent on the state of the device, as recited by Claims 1 and 15.

As a preliminary matter, Kumagai does not teach or suggest a key wherein “the function of the key is dependent upon the state of the device,” as recited by both Claims 1 and 15. Rather, as the Examiner acknowledges in the Office Action, the keys in Kumagai perform only a single function and thus cannot be multifunctional.

As noted in the Office Action, Kumagai discloses that, with the lid closed, the telephone is able to receive an incoming call as well as to transmit a call to another party via the telephone directory. Kumagai, Col. 4, lines 18–30; Office Action, pages 8–9. There is no mention in Kumagai, however, of the telephone

¹ If the claims are otherwise in allowable form, Applicant would be amenable to amending Claims 2–12, 14, and 16–21 in accordance with the Examiner’s request that the phrase “a device” be corrected to read “the device” in order to address the 35 U.S.C. § 112 rejection.

directory retrieving keys **32a, 32b** having one function when the telephone is receiving calls (for example) and another function when the telephone is transmitting calls. In fact, the Office Action itself recognizes that the keys of Kumagai are not multifunctional; therefore, the keys cannot, by definition, have one function when the phone is in one state and another function when the phone is in a different state as this would require the keys to have more than a single function. Office Action, pgs. 3 and 6.

It is, at best, the operability (*i.e.*, whether the retrieving keys **32a, 32b** are active at all) of the keys **32a, 32b** that is dependent on the state of the device in Kumagai, with the keys **32a, 32b** being inactive, for example, when there is an incoming call. However, even this is not explicitly described in the disclosure of Kumagai. Regardless, the Office Action misinterprets Kumagai as Kumagai does not teach or suggest a key wherein “the function of the key is dependent upon the state of the device,” as recited by both Claims 1 and 15. Therefore, Kumagai does not disclose this element of Claims 1 and 15.

B. Neither Kumagai nor Inoue teaches or suggests a multifunctional key that is “in a position that is remote from all other keys,” as recited by Claim 1.

Neither Kumagai nor Inoue teaches or suggests a multifunctional key that is “in a position that is remote from all other keys,” as recited by Claim 1. Rather, both Kumagai and Inoue disclose multiple keys on the respective telephones, none of which is remote from all the other keys. Therefore, the combination of Kumagai and Inoue cannot render obvious Claim 1 or the claims that depend therefrom (*i.e.*, Claims 2-12, 14).

As noted above, Kumagai does not teach a multifunctional key at all, let alone a multifunctional key that is remote from all other keys. In fact, in Kumagai, multiple single-function keys **30, 31, 32a, 32b** are accessible on the lid **17** of the portable phone when the lid is closed. Kumagai, Fig. 5; col. 3 line 61 through col. 4 line 30. Figure 5 of Kumagai clearly shows two keys (a transmitting button **30** and a hook switch **31**) on one side of the liquid crystal section **12** and two keys (telephone directory retrieving keys **32a, 32b**) on the other side of the liquid crystal section **12**. Thus, the transmitting button **30** is not remote from all other keys because it is positioned adjacent to the hook switch 31, and the hook switch **31** is not remote from all other keys because it is positioned adjacent to the transmitting button 30. Likewise, key **32a** is not remote from all other keys because it is positioned adjacent to key 32b, and key **32b** is not remote from all other keys because it is positioned adjacent to key 32a.

The Office Action insists that “key **32a** or key **32b** is on the surface of lid **17** and remote from the other keys.” However, as stated above, Kumagai does not disclose that either of the keys **32a, 32b** are in a position remote from all other keys. Furthermore, Kumagai teaches away from separating the keys **32a, 32b** because the function of one of the keys **32a, 32b** is directly related to the function of the other of the keys—one of the keys **32a** scrolls the telephone directory up, and the other key **32b** scrolls the telephone

directory down. Fig. 5; Office Action, pg. 8. Therefore, it would be counterintuitive for someone practicing the invention of Kumagai to separate the keys **32a**, **32b** such that each key is remote from all other keys as the keys are intended to be used together to navigate the telephone directory.

Inoue does not cure the deficiencies of Kumagai because Inoue, also, does not teach or suggest a multifunctional key that is “in a position remote from all other keys,” as recited by Claim 1. Rather, the figures and disclosure of Inoue describe the main soft key **3** as being positioned between the first auxiliary soft key **4A** and the second auxiliary soft key **4B**, as well as proximate the key group **5**. Inoue, Figs. 1A, 4-9, 10A, 13, and 14; col. 5, lines 8–11. In another embodiment, a single roller soft key **31** is provided that includes a main soft key section **31C**, a first auxiliary soft key section **31A**, and a second auxiliary soft key section **31B** that can be actuated to realize the functions of the main soft key **3**, first auxiliary soft key **4A**, and second auxiliary soft key **4B**. Figs. 16–17; col. 18, lines 46–61. However, even the single roller soft key **31** is not remote from other keys as it is near the keys in the key group **5** and thus is not “remote from all other keys” when the flip 9 is in the open position. Fig. 16.

Thus, neither Kumagai nor Inoue, alone or in combination, teaches or suggests a multifunctional key that is “in a position remote from all other keys,” as recited by Claim 1. Rather, each reference discloses keys that are positioned adjacent or otherwise near other keys. Therefore, for at least these reasons, Claim 1, and the claims that depend therefrom, is patentable.

C. Neither Kumagai nor Inoue teaches or suggests a multifunctional key that is “the only key disposed on a first surface of the cover,” as recited by Claim 15.

Neither Kumagai nor Inoue teaches or suggests a multifunctional key that is “the only key disposed on a first surface of the cover,” as recited by Claim 15. Rather, Kumagai describes multiple keys on the lid, and Inoue does not teach positioning any of the multifunctional keys on the flip. Therefore, the combination of Kumagai and Inoue cannot render obvious Claim 15 or the claims that depend therefrom (*i.e.*, Claims 16–21).

As discussed above, Kumagai describes at least four keys positioned on the lid **17**, as shown in Fig. 5—a transmitting button **30**, a hook switch **31**, and telephone directory retrieving keys **32a**, **32b**. None of the figures or the embodiments described in Kumagai discloses or suggests a single key disposed on a first surface of the cover, as recited by Claim 15.

With regard to Inoue, none of the soft keys **3**, **4A**, **4B**, or **31** taught by Inoue are located on the flip **9**. In fact, Inoue teaches away from including a soft key **3**, **4A**, **4B**, or **31** on the flip **9**. This is because positioning the keys **3**, **4A**, **4B**, or **31** on the flip **9** would render the keys inaccessible when the flip **9** is opened, and Inoue explicitly states that having the keys “visible all the time . . . allows the usability for a user to significantly be improved.” Col. 5, lines 54–56. The only key that is shown on the flip **9** of Inoue is

an information key **21**, which is not a multifunctional key as it functions solely to make “a connection to the Internet.” Fig 10B, col. 15, lines 37–39.

Thus, neither Kumagai nor Inoue, alone or in combination, teaches or suggests a multifunctional key that is “the only key disposed on a first surface of the cover,” as recited by Claim 15. Rather, Kumagai discloses multiple keys on the lid, and Inoue teaches away from including keys on the flip. Therefore, for at least these reasons, Claim 15, and the claims that depend therefrom, is patentable.

D. Claim 8 is not obvious over Kumagai and Inoue in view of Kim.

The Office Action does not suggest that Kim cures the above-noted deficiencies of Kumagai and Inoue, and Applicant asserts that Kim does not cure the deficiencies. Accordingly, reversal of this rejection is requested on the same basis as described above.

V. Conclusion

Neither Kumagai nor Inoue teaches or suggests a multifunctional key that is “in a position that is remote from all other keys,” as recited by Claim 1. Furthermore, neither Kumagai nor Inoue teaches or suggests a multifunctional key that is “the only key disposed on a first surface of the cover,” as recited by Claim 15. Thus, the combination of Kumagai and Inoue does not render the claimed invention obvious because neither reference, taken alone or in combination, teaches all the elements of the independent claims. Therefore, independent Claims 1 and 15 are patentable for at least the reasons stated above.

Claims 2–12, 14, and 16–21 depend either directly or indirectly from a respective one of independent Claims 1 and 15 and, as such, include all the recitations of their respective independent claims. The dependent Claims 2–12, 14, and 16–21 are therefore patentably distinct from Kumagai, Inoue, and Kim, alone or in combination, for at least the same reasons as given above for independent Claims 1 and 15.

Accordingly, for at least all the reasons stated above, Applicant respectfully submits that the rejections of Claims 1–12 and 14–21 should be reversed.